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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,191	12/21/2001	Philippe Collas	50195/003002	4902
21559	7590	11/02/2005		
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110			EXAMINER WOITACH, JOSEPH T	
			ART UNIT	PAPER NUMBER

1632

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,191

Applicant(s)

COLLAS ET AL.

Examiner

Joseph T. Voitach

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-15 and 43-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-15 and 43-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 15, 2005, has been entered.

DETAILED ACTION

This application filed January 9, 2002, claims benefit to provisional application 60/258,151, filed December 22, 2000.

Applicants' amendment filed July 13, 2005, has been received and entered. Applicants supplemental amendment filed October 14, 2005, have been received and entered. The specification has been amended. Claims 1, 4, 6, 15 and 43 have been amended. Claims 2, 3, 16-42 have been canceled. Claims 1, 4-15, 43-53 are pending.

Election/Restriction

Applicant's election without traverse of Group I was acknowledged. Claims 16-42 previously withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions have been cancelled.

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Claims 1, 4-15 and 43-53 drawn to a method of cloning a non-human mammal comprising incubating a permeabilized cell in a reprogramming media to form a reprogrammed cell are currently under examination.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or was acknowledged. In the amendment to the specification deleting the information to provisional application Applicant does not comply with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a).

Accordingly, the present application is given the priority date as of its filing, December 21, 2001.

Claim Objections

Claims 51 and 52 objected to because the reference to step (b) recited in the claims appears to be incorrect is withdrawn.

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The amendment in the first file amendment (July 13, 2005) to the claims to recite step (c) as suggested has addressed the basis of the objection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-15, 43-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn.

Applicants amendments to the claims, arguments and support provided in the declaration filed by Dr. James M. Robl under 37 CFR 1.132 is found sufficient to address the basis of the rejection for the breadth of the claims, in particular to the type of extract and source of extract used in the claimed invention.

Claims 45-50 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is withdrawn.

The amendment to the claims has addressed the basis of the rejection.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

Claims 1, 4-15, 43-53 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

The IDS filed July 13, 2005, contains a Invention Disclosure Form wherein the instant invention is disclosed and discussed. The form is signed and dated 11/23/1998, and only provides for one inventor, James M. Robl. The basis of the instant rejection focuses on the difference between the inventors associated with the invention in Invention Disclosure Form (dated 11/23/1998) and that instantly claimed.

Additionally, claims 1, 4-15, 43-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Invention Disclosure Form dated 11/23/1998. As noted above, the information provided in the Invention Disclosure Form provides the basis for the claimed invention. There is no indication on the form to its confidentiality (as compared to a second Invention Disclosure Form dated 7/7/2000 also provided), and it is assumed that it was publicly available prior to the priority date of the instant application.

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Claims 1, 4-15, 43, 51-53 rejected under 35 U.S.C. 102(e) as being anticipated by Chapman (US Patent Pub. No. 2002/0001842 A1) is withdrawn.

Claims 1, 7, 9-15 and 43, 51-53 are under 35 U.S.C. 102(e) as being anticipated by Machatay *et al.* (US Patent 6,211,429) is withdrawn.

Amending the claims to require a functional limitation to the mitotic cell extract has differentiated the claimed invention from that disclosed by the cited references. While the prior art teaches some aspects of the claimed invention, they do not disclose extracts with particular and specific properties.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-15, 43-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Applications Robl *et al.* (2004/0068760) and Collas *et al.* (2002/0142397 A1).

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Applicants do not discuss the specific merits of the rejection and request to hold the rejection in abeyance until allowable subject matter is indicated. See Applicants amendment, page 10.

Applicants' request is noted, however a rejection can not be held in abeyance and no allowable subject matter has been indicated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claim is allowed.

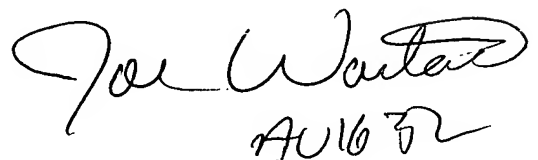
The claims are free of the art of record because while there was general teaching and motivation to use cell extracts to reprogram a donor cell, there was no specific teaching in obtaining an extract with the particular functional properties required by the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (571)272-0734.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571)272-0532.

Joseph T. Woitach



Joe Woitach
AU 1632